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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARK D. KLEIN, JASON BROWNE, and
CRAIG DOUGAL PATERSON

Appeal 2016-005940
Application 12/618,950
Technology Center 3600

Before ELENI MANTIS MERCADER, LARRY J. HUME, and
CATHERINE SHIANG, *Administrative Patent Judges*.

SHIANG, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1–6, 8–10, 12–15, 17–28, 30, 31, 33–36, and 38, which are all the claims pending and rejected in the application. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

STATEMENT OF THE CASE

Introduction

According to the Specification, the present invention relates to content delivery. *See generally* Spec. 1. Claim 1 is exemplary:

1. A method comprising:
 - associating corresponding panelists of a plurality of panelists with corresponding groups based on one or more characteristics of the panelists;
 - generating first signatures or collecting first human-inaudible codes to identify first media exposed to a first panelist of the plurality of panelists;
 - accessing, with a computing device, notifications of first Internet actions performed by the first panelist;
 - correlating, with the computing device, the first Internet actions with exposure to the first media;
 - determining a first effectiveness score of the first media in affecting behavior of a first one of the groups of panelists based on the correlation of the first Internet actions with the exposure to the first media;
 - generating second signatures or collecting second human-inaudible codes to identify second media exposed to the first panelist or to a second panelist of the plurality of panelists, the second panelist and the first panelist belonging to a same one of the groups;
 - accessing, with the computing device, notifications of second Internet actions performed by the first panelist or the second panelist;
 - correlating, with the computing device, the second Internet actions with exposure to the second media;
 - determining a second effectiveness score of the second media in affecting behavior for the first group based on the correlation of the second Internet actions with the exposure to the second media;
 - performing a comparison of the first effectiveness score and the second effectiveness score to determine a higher effectiveness score for affecting the first group;
 - accessing data indicative of a characteristic of a user who is not a panelist;
 - associating the user with the first group based on the characteristic of the user;
 - selecting, with the computing device, the first media or the second media for presentation to the user based on the higher effectiveness score and the first group with which the user is associated; and
 - electronically transmitting the selected one of the first media or the second media from the computing device for presentation to the user.

Rejection

Claims 1–6, 8–10, 12–15, 17–28, 30, 31, 33–36, and 38 stand rejected under 35 U.S.C. § 101 as being directed to patent-ineligible subject matter.

ANALYSIS

We disagree with Appellants’ arguments, and agree with and adopt the Examiner’s findings and conclusions in (i) the action from which this appeal is taken and (ii) the Answer to the extent they are consistent with our analysis below.¹

The Examiner rejects the claims under 35 U.S.C. § 101 because they are directed to patent-ineligible subject matter. *See* Final Act. 3–9; Ans. 2–19. In particular, the Examiner finds the claims are directed to the abstract idea of collecting, analyzing, accessing, and transmitting information. *See* Ans. 6; *see also* Final Act. 3–9; Ans. 2–19. The Examiner further finds the claims use generic computer components to perform generic computer functions. *See* Ans. 6; *see also* Final Act. 3–9; Ans. 2–19. Appellants argue the Examiner erred. *See* App. Br. 18–50; Reply Br. 2–15.

Appellants have not persuaded us of error. Section 101 of the Patent Act provides “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. That provision “contains an important implicit exception: Laws of nature, natural phenomena, and

¹ To the extent Appellants advance new arguments in the Reply Brief without showing good cause, Appellants have waived such arguments. *See* 37 C.F.R. § 41.41(b)(2).

abstract ideas are not patentable.’” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). According to the Supreme Court:

[W]e set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts. First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. . . . If so, we then ask, “[w]hat else is there in the claims before us?” . . . To answer that question, we consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. . . . We have described step two of this analysis as a search for an “‘inventive concept’” —*i.e.*, an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

Alice Corp., 134 S. Ct. at 2355.

The Federal Circuit has described the *Alice* step-one inquiry as looking at the “focus” of the claims, their “character as a whole,” and the *Alice* step-two inquiry as looking more precisely at what the claim elements add—whether they identify an “inventive concept” in the application of the ineligible matter to which the claim is directed. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1346 (Fed. Cir. 2015).

Regarding *Alice* step one, the Federal Circuit has “treated *collecting information*, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas.”

Elec. Power, 830 F.3d at 1353 (emphasis added); *see also Internet Patents*, 790 F.3d at 1348–49; *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1363 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014). “In a similar vein, we have treated *analyzing information* [including manipulating information] by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also In re TLI Commc’ns. LLC Patent Litig.*, 823 F.3d 607, 613 (Fed. Cir. 2016). “And we have recognized that *merely presenting the results of abstract processes of collecting and analyzing information, without more* (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis.” *Elec. Power*, 830 F.3d at 1354 (emphasis added); *see also Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 714–15 (Fed. Cir. 2014).

The rejected claims “fall into a familiar class of claims ‘directed to’ a patent-ineligible concept.” *Elec. Power*, 830 F.3d at 1353. Contrary to Appellants’ arguments (App. Br. 18–50; Reply Br. 2–15), the claims are similar to the claims of *Electric Power*, and are focused on the combination of abstract-idea processes or functions. *See Elec. Power*, 830 F.3d at 1354.² For example, claim 1 is directed to collecting and accessing information (“collecting first [and second] human-inaudible codes . . .; accessing . . .”), analyzing and generating information (“associating. . .; generating first [and

² As acknowledged by Appellants (Appeal Br. 25), *PNC Bank v. Secure Access, LLC*, Case No. CBM2014-00100 (PTAB Sept. 9, 2014) is not precedential and not controlling.

second] signatures . . .; correlating . . . the first [and the second] Internet actions . . .; determining a first [and second] effectiveness score . . .; performing a comparison . . .; selecting . . .”), and transmitting information (“transmitting the selected one of the first media . . .”). *See Elec. Power*, 830 F.3d at 1353.

Similarly, independent claim 28 is directed to collecting and accessing information, analyzing and generating information, and transmitting information. *See* claim 28. Likewise, independent claim 33 is directed to collecting and accessing information, analyzing (including monitoring) information, and generating information. *See* claim 33.

The dependent claims are directed to similar abstract functions or processes, and Appellants have not shown such claims are directed to other non-abstract functions or processes. *See* claims 2–6, 8–10, 12–15, 17–27, 30, 31, 34–36, and 38. In particular, contrary to Appellants’ arguments, the following dependent claims are directed to similar abstract functions or processes. Dependent claim 5 recites additional limitations that are directed to collecting information (“receiving . . .”), analyzing (including monitoring) information (“monitoring . . .” and “correlating . . .”), and presenting information (“presenting . . .”). *See* claim 5. Dependent claim 17 recites “wherein transmitting the selected media includes: obtaining . . .; inserting . . .; and transmitting . . .”), and the additional limitations are directed to collecting, analyzing (including inserting), and transmitting information. *See* claim 17. Dependent claim 19 further includes limitations that are directed to analyzing and modifying information (“modifying . . .”), and transmitting information (“transmitting . . .”). Dependent claim 26 further includes limitations that are directed to analyzing information (“generating .

. . .; performing a comparison . . .; and . . . identifying”). Dependent claim 38 further includes limitations that are directed to collecting information (“acquiring . . .”), and analyzing information (“detecting . . .; dynamically adjusting”).

Further, Appellants’ assertion regarding pre-emption (App. Br. 33–34, 39; Reply Br. 3–4) is unpersuasive, because “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility. . . . Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP*, 788 F.3d at 1362–63 (“that the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract”).

Regarding *Alice* step two, contrary to Appellants’ assertion (App. Br. 34–50; Reply Br. 8–15), Appellants have not shown the claims in this case require an arguably inventive set of components or methods, or invoke any assertedly inventive programming. *See Elec. Power*, 830 F.3d at 1355.

Further, contrary to Appellants’ arguments (App. Br. 34–50; Reply Br. 8–15), the claims are similar to the claims of *Electric Power*, because they do not require any nonconventional computer, network, or display components, or even a “non-conventional and non-generic arrangement of known, conventional pieces,” but merely call for performance of the claimed information collection, analysis, transmission, and presentation functions on generic computer components and display devices. *See Elec. Power*, 830 F.3d at 1355; *see also* Claim 1 (reciting “a computer device . . .

.”); Claim 28 (reciting “a processor . . . the computing device”); Claim 33 (reciting “monitoring devices . . . a processor”). The dependent claims call for similar generic components and devices, and Appellants have not shown such claims require any non-conventional components or devices. *See* claims 2–6, 8–10, 12–15, 17–27, 30, 31, 34–36, and 38.

In short, Appellants have not shown the claims, read in light of the Specification, require anything other than conventional computer, network, and display technology for collecting, analyzing, and presenting the desired information. *See Elec. Power*, 830 F.3d at 1354. Such invocations of computers and networks are “insufficient to pass the test of an inventive concept in the application” of an abstract idea. *See Elec. Power*, 830 F.3d at 1355.

Finally, Appellants’ citing *Research Corp. Technologies Inc. v. Microsoft Corp.*, 627 F.3d 859 (Fed. Cir. 2010) (Reply Br. 4)—a case predated the *Alice* decision and does not employ the *Alice* steps—is unhelpful. As discussed above, Appellants have not shown the claims are patent eligible under the *Alice* steps. Further, as discussed above, the claims here recite inventions that are merely the routine or conventional use of the technology—the opposite of what the claims of *Research Corp. Technologies* represent. *See Research Corp. Technologies Inc.*, 627 F.3d. at 868–69. Likewise, Appellants’ assertion that the present claims are distinguishable from the claims of *Digitech Image Technologies, LLC v. Electronics for Imaging, Inc.*, 758 F.3d 1344 (Fed. Cir. 2014), *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014), and *Classen Immunotherapies, Inc. v. Biogen IDEC*, 659 F.3d 1057 (Fed. Cir. 2011) (Reply Br. 5–7)—regardless of whether they are true—are unpersuasive: as

discussed above, the claims are similar to the claims of *Electric Power* and are patent ineligible.

Because Appellants have not persuaded us the Examiner erred, we sustain the Examiner's rejection of claims 1–6, 8–10, 12–15, 17–28, 30, 31, 33–36, and 38 under 35 U.S.C. § 101.

DECISION

We affirm the Examiner's decision rejecting claims 1–6, 8–10, 12–15, 17–28, 30, 31, 33–36, and 38.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED